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EXAMINER
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LIN, KENNY S

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/726,973  
Filing Date: November 30, 2000  
Appellant(s): SIEGEL ET AL.

**MAILED**

**DEC 04 2006**

**Technology Center 2100**

\_\_\_\_\_  
Raymond B. Churchill, Jr.  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 9/11/2006 appealing from the Office action mailed 8/19/2005.

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**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

Claims 1 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Published Application 2002/0013850 to Mitchell in view of U.S. Patent No. 6,847,992 to Haitsuka.

### **NEW GROUND(S) OF REJECTION**

Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

#### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

#### **(8) Evidence Relied Upon**

2002/0013850	Mitchell et al.	1-2002
6,847,992	Haitsuka et al.	1-2005
6,606,581	Nickerson et al.	8-2003
6,836,799	Philyaw et al.	12-2004
6,701,362	Subramonian et al.	3-2004

#### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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2. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Nowhere in the specification disclosed to *assign a unique ID to each device among a plurality of devices used for presenting the personalized information; present information to the user based upon the unique ID of the device used to access the host web site; and wherein the content of the information presented to the user is different for each unique ID assigned to each device among the plurality of devices.* Paragraph 9 of the specification only disclosed that “a user may be assigned a unique identify that is linked to the personal computer (PC) used to access the host web site”; Paragraphs 6 and 12, in summary, disclose to personalize the information presented to the user based upon the identifying data collected from the user and the subject matter content of the visited web sites to the user during the subsequent visit. **The specification DO NOT disclose *modifying the content of the information presented to the user based upon the unique ID of the device used to access the host web site.*** Furthermore, the figures fail to disclose the use of unique ID of devices. Figure 2 only shows the steps for a user to register with a host web site by inputting user profile data, receive a cookie from the host web site, surf web pages and storing information of the sites visited on the cookie, and host web site presenting personalized information based on the cookie. Figure 3 only shows an interface or inputting user profile information for registration with the host web site. **None of the figures explicitly teach or suggest the use of unique ID of the devices used for accessing the host web site nor to modify contents of the information presented based on the unique ID.** The

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specification also fails to present different information *for each unique ID* assigned to each device among the plurality of devices. Paragraph 9 of the specification only disclose to present different content for each computer based on the information stored by the server or cookie. Nowhere in the specification disclose to present different content to the user for *each unique ID* assigned to each device among the plurality of devices.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 4-7, 13 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell et al (hereinafter Mitchell), US 2002/0013850, filed on June 28, 2001 with an earlier effective filing date of June 28, 2000, in view of Haitsuka et al (Haitsuka), US 6,847,992.

5. As per claims 1 and 15, Mitchell taught the invention substantially as claimed a method of personalizing information presented at a host web site comprising:

- a. Using the host web site for obtaining personal data/collecting identifying data about a user during a visit to the host web site (pp. 0034, 0048-0049; entering registration data);

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- b. After the host web site obtains the personal data about the user/collects the identifying data, using the host web site for monitoring the content of information viewed by the user while the user visits other web sites (pp. 0052; application server may then send aggregated transactional assets to personal profile data store; pp. 0055, click-stream data is stored in a personal preferences database, data derived from pages accessed by the network user); and
- c. During a subsequent visit by the user to the host web site, personalizing the information presented to the user, wherein the host web site modifies the content of the information presented to the user based upon the personal data obtained/identifying data collected about the user and the content of the other web sites visited by the user (pp. 0049; repeat network user systems may be automatically recognized and served with the appropriate customized web page; pp. 0050-0055; interactive presentation service creating the web site).

6. Mitchell further taught to use cookies for storing user ID (pp. 0049). Mitchell did not specifically teach to assign a unique ID to each device among a plurality of devices used for presenting the personalized information; presenting content based upon also the unique ID of the device used to access the host web site and that the content of the information presented to the user is different for each unique ID assigned to each device among the plurality of devices. Haitsuka taught to assign a unique ID (e.g. cookie) to each device among a plurality of devices used for presenting the personalized information (col.2, lines 64-67, col.3, lines 1-3, 11-20; cookie is inherently known to contain user or device identification: *a cookie is information that a*

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*web server puts on a user's hard disk so that the web server can remember something about the user at a later time.* e.g. identifying a user) and to present the content information based upon the unique ID of the device (e.g. assigned cookie) used to access the host web site (col.3, lines 11-15) and that the content of the information presented to the user is different for each unique ID assigned to each device (col.3, lines 11-20; computer-specific). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mitchell, and Haitsuka because Haitsuka's teaching of using cookies to store information enables Mitchell's method to store the user identification, user information (e.g. preference) and visited web contents on a hard disk on the user's workstation in a cookie and eliminate the need for storing these user-related information in a storage located at the host site (see Haitsuka, col.2, lines 64-67, col.3, lines 1-20).

7. As per claim 2, Mitchell and Haitsuka taught the invention substantially as claimed in claim 1. Mitchell further taught that wherein the content of the information presented to the user during the subsequent visit to the host web site is related to the personal data obtained from the user (pp. 0052, 0055).

8. As per claim 7, Mitchell and Haitsuka taught the invention substantially as claimed in claim 2. Mitchell further taught to continuously updating the content of the information presented to the user during each subsequent visit to the host web site, wherein the content of the information is updated in response to any changes in the personal data for the user or in the content of the other web sites visited by the user (pp. 0050-0055).



9. As per claim 13, Mitchell and Haitsuka taught the invention substantially as claimed in claim 1. Mitchell further taught that wherein the personal data about the user includes any information used to identify the user as a unique individual (pp. 0048-0049).

10. As per claims 4 and 16, Mitchell taught the invention substantially as claimed in claims 1 and 15. Mitchell further taught to placing cookie on a hard disk of the user (pp. 0049; cookie is known inherently to be stored in client device). Mitchell further taught to record personal data about the user/information related to the identifying data of the user (pp. 0048-0049). Mitchell did not specifically teach the method to comprise recording the personal data about/information related to the identifying data of the user and the content of the other web sites visited by the user on the cookie. Haitsuka taught store personal data of the user and the content of the other web sites visited by the user on the cookie (col.2, lines 64-67, col.3, lines 1-20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mitchell, and Haitsuka because Haitsuka's teaching of using cookies to store information enables Mitchell's method to store user information and visited web contents on a hard disk on the user's workstation in a cookie and eliminate the need for storing these user-related information in a storage located at the host site (see Haitsuka, col.2, lines 64-67, col.3, lines 1-20).

11. As per claims 5-6 and 17, Mitchell and Haitsuka taught the invention substantially as claimed in claims 4 and 16. Haitsuka further taught to retrieve from the cookie the personal data

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of the user and the content of the other web sites visited by the user to the host web site during each subsequent visit to the host web site (col.2, lines 64-67, col.3, lines 1-20).

12. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell and Haitsuka as applied to claim 17 above, and further in view of Philyaw et al (hereinafter Philyaw), US 6,836,799.

13. As per claim 18, Mitchell, and Haitsuka taught the invention substantially as claimed in claim 17. Mitchell and Haitsuka did not specifically teach to continuously updating the information recorded on the cookie. Philyaw further taught to continuously updating the information recorded (col.26, lines 44-54). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mitchell, Haitsuka and Philyaw because Philyaw's teaching of the storing content of other web sites with user information in user profile enables Mitchell and Haitsuka's method to properly and continuously update user profile stored in the cookie in accordance to contents of the user visited web sites and user interests (col.26, lines 44-54).

14. Claims 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell and Haitsuka as applied to claim 1 above, and further in view of "Official Notice".

15. As per claims 8-11, Mitchell and Haitsuka taught the invention substantially as claimed in claim 1. Mitchell and Haitsuka did not specifically teach that wherein the content of the other

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web sites visited by the user includes the URL addresses of the visited web sites, the length of time spent viewing, any applets that are downloaded or the number of times the user visits each of the other web sites. Official Notice is taken that the limitation narrowed by these claims are considered obvious and furthermore a matter of design choice in obtaining statistics or information. Since applicants have not disclosed that the claimed limitation solve any stated problem or are for any particular purpose, it appears that the invention would perform equally well without the claimed features. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include different statistics tracking or calculation and downloaded applets that is needed to support the web site as part of the content obtained.

16. As per claim 12, Mitchell and Haitsuka taught the invention substantially as claimed in claim 1. Mitchell and Haitsuka did not specifically teach to comprise presenting the personalized information on a device selected from the group consisting of personal computers, a laptop computer, set top boxes, wireless phones, pagers and personal digital assistants.

However, Official Notice is taken that the limitations narrowed by this claim is considered obvious and furthermore a matter of design choice, since applicants have not disclosed that the claimed limitations solve any stated problem or are of any particular purpose and it appears that the invention would perform equally well without these claimed features. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to efficiently utilize the claimed method in all types of presenting devices.

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17. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell and Haitsuka as applied to claim 1 above, and further in view of Subramonian et al (hereinafter Subramonian), US 6,701,362.

18. As per claim 3, Mitchell and Haitsuka taught the invention substantially as claimed in claim 1. Mitchell and Haitsuka did not specifically teach to further comprising obtaining authorization from the user to monitor the other web sites visited by the user. Subramonian taught that the monitoring and collecting step is performed only if it is authorized by the user (col.11, lines 66-67). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Mitchell, Haitsuka and Subramonian because Subramonian's teaching of authorizing prior to collecting and monitoring user activities would prevent Mitchell and Haitsuka's method from invading the privacy of the users.

19. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell and Haitsuka as applied to claim 13 above, and further in view of Nickerson et al (hereinafter Nickerson), US 6,606,581.

20. As per claim 14, Mitchell and Haitsuka taught the invention substantially as claimed in claim 13. Mitchell and Haitsuka did not specifically teach wherein the personal data includes the user's name, address, zip code, occupation, phone number, education level, income, marital status, citizenship, home ownership status, age and health. Nickerson taught to include user's name, address, zip code, occupation, phone number, education level, income, marital status,

home ownership status, age and other personal information as the personal data (col.15, lines 61-67, col.6, lines 1-8). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Mitchell, Haitsuka and Nickerson because Nickerson's teaching of personal data requirement would provide a more detailed personal data collection in Mitchell and Haitsuka's method.

#### **(10) Response to Argument**

The examiner summarizes the various points raised by the appellant and addresses replies individually.

As per appellant's argument that:

(1) Examiner relied on Haitsuka to teach the feature of assigning a unique ID to each device among a plurality of devices. The examiner stated with regard to Haitsuka, that a cookie is inherently known to contain device identification. As disclosed in Haitsuka, cookies merely allow a server to record its own information about a user's specific information with respect to a particular website. Haitsuka discloses that a cookie is a mechanism that allows a web server to store its own information about a user on the user's own computer. This does not render the claims subject matter inherent as the claimed personalization of the website is based on the content of other websites and a unique ID for the user device. There is no express or inherent disclosure for storing a unique ID for a user device in the cookie as suggested by the examiner.

#### **In reply to argument (1):**

Appellant stated that the reference do not teach to assign unique ID to each devices by forcing argued that cookies do not inherently include unique ID. However, appellant fails to see

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that the examiner rejected the claims basing on the fact that the **cookie is the unique ID as disclosed** in the appellant's specification.

Appellant cited paragraph 9 of the specification to show support of the claimed limitation of "*assigning a unique ID to each device among a plurality of devices used for presenting the personalized information*" and raised arguments to question the examiner's rejection of mapping "cookie" with the claimed language of "unique ID of the device" believing that cookie may not have unique ID of the device. In contradiction, paragraph 9 of the appellant's specification further disclosed an example to show the embodiment of "a user may be assigned a unique identity that is linked to the personal computer (PC) used to access the host web site" that the *host web site is, in fact, assigning cookies* to the user's computers" as the unique ID of the device (see paragraph 9 recited below).

Paragraph 9 of the specification is recited:

[0009] In certain preferred embodiments, a user may be *assigned a unique identity* that is linked to the personal computer (PC) used to access the host web site. *For example, a user may visit business related web sites from a first PC at work and entertainment related sites from a second PC at home. The host web site of the present invention desirably assigns a first cookie to the user's work PC and a second cookie to the user's home PC. The cookie assigned to the work PC will track and monitor the web sites that the user visits at work. This information will be stored in a database maintained by the server of the host web site. The cookie assigned to the home PC will track and monitor the web sites that the user visits at home. This information will also be stored by the server of the host web site. The information stored about usage of the work PC will have a different content than the information stored on usage of the home PC. As a result, the user's experience when visiting the host web site may be very different depending upon which PC is utilized to visit the host web site.*

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In appellant's own example, the *cookie* assigned to the computer is **in equivalent** with the *unique identity of the device*. Therefore, in light of the specification, cookies inherently stores or functions as unique identity of the device.

There are no other disclosures in the specification supporting the claimed limitation regarding the use of *unique ID of the device* (if unique ID is not cookie as argued by the appellant). According to paragraph 9, *the user's experience when visiting the host website may be different depending upon which PC is utilized basing on the information monitored and tracked by the cookie of that PC* clearly shows that the assigned cookie may function and represent the unique ID of the device; especially when this is the only support in the entire specification for the claimed limitation of "*the content of the information presented to the user is different for each unique ID assigned to each device among the plurality of device*".

Furthermore, appellant's detail description in paragraph 21 of the specification disclosed to assign cookie to the user's device, rather than a unique ID. No other support can be found to assign unique ID to devices if the term *unique ID of the device* is forced to be interpreted differently from *cookies*.

Since appellant's specification evidently and repeatedly show that cookies are in fact the unique identities of the devices, appellant's argument that "cookie" taught by Mitchell and Haitsuka references do not inherently store a unique ID, is in contradiction to the appellant's disclosure since the appellant disclosed to use cookie as the unique ID.

A "cookie" is also known in the art to *identify users*, to instruct the server to send a customized version of the requested Web page, to submit account information for the user, and for other administrative purposes. Haitsuka also taught that cookies are computer-specific (i.e.

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unique for each computer; col.3, lines 14-20) and each computer has a different set of cookies generated by the web server (cookies are computer specific since they are used to customize web pages for user based on the computer's browser type, user preference entered and other information provided to the web server from the computer). The use of cookie storing user ID used for accessing network is taught in Mitchell in paragraph 0049. Haitsuka taught to assign unique ID (e.g. cookie) to each device among a plurality of devices used for presenting the personalized information (col.2, lines 64-67, col.3, lines 1-3, 11-15: *cookies can be used by web server to customize pages for user based on the user's browser type or other information the user might have provided the web serve*) and to present the content information based upon the unique ID of the device (e.g. cookie assigned on user's hard disk) used to access the host web site (col.3, lines 11-15) and that the content of the information presented to the user is different for each unique ID assigned to each device (col.3, lines 11-20; computer-specific).

Last, in response to the after-final request for reconsideration filed on 12/22/2005, the examiner provided a reference, Pogue et al., US Patent 6,112,240, published on August 29, 2000 with an effective filing date of September 3, 1997, to show that cookies is known to store or function as device unique identifier (see Pogue, col.7, lines 3-6: *cookie may include unique identification number identifying the client computer*).

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.



This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

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Respectfully submitted,

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*KL*

  
Jack E. Harvey, Director  
Technology Center 2100

A Technology Center Director or designee must personally approve the new  
ground(s) of rejection set forth in section (9) above by signing below:

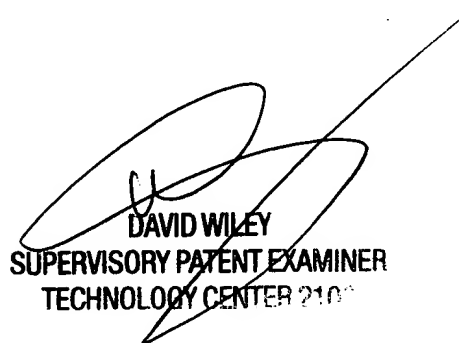
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Conferees:

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SUPERVISORY PATENT EXAMINER

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